

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3 April 2008 has been entered.

Claim Rejections - 35 USC § 102 and 35 USC § 103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-9,12-16 and 18-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Schulze, Jr. (US005483049A).
5. Schulze, Jr. teaches (independent claims 1, 13, 18 and 22) a method and system for issuing/providing exchange *coupons 40* and redemption *checks 48*, either of which reads on “partnership checks”¹, the method comprising:

analyzing a group of merchants based on a set of merchant qualification criteria, wherein the set of merchant qualification criteria is analyzed using a statistical analysis method that

¹ From the definitions of a “partnership check” and a “value sharing relationship” in para. [0026] of the published application (US 20030126011A1).

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considers at least one factor associated with each merchant in the group of merchants² (*geographic region*, col. 18 lines 34-39);

identifying one merchant (*the retail sales store*, col. 2 lines 66-67) of the group of merchants for associating with partnership checks (*exchange coupons*, col. 2 line 66) based on the analysis;

creating the *exchange coupons 40*/partnership checks such that the *exchange coupon 40*/partnership checks are redeemable with the one merchant (col. 2 line 65 to col. 3 line 4 and col. 3 line 60 to col. 4 line 5); and

sending the created *exchange coupons 40*/partnership checks to a set of customers (*consumers*, col. 18 lines 14-19).

For claim 13, forming a “value sharing relationship” with at least one *retailer* (merchant) is taught at col. 1 line 62 to col. 2 line 24). For claim 18, “generating a list of prospective merchants” is inherent (col. 18 line 38 teaches *retail outlets*, which reads on a list of prospective merchants; that said list exists must mean that it was generated); “generating/analyzing a list of prospective customers” is taught at col. 6 lines 58-67 and col. 3 line 1).

6. The following claim language is non-functional descriptive material and was not given patentable weight (MPEP § 2106.01):

“wherein each partnership check includes an account number associated with a respective customer in the set of customers and a routing number” (e.g., at the last two lines of claim 1); and

“wherein the value sharing relationship allows the issuer and the at least one merchant to share the value provided by use or issuance of at least one of the partnership checks” (e.g., claim 13 lines 5-7).

In the sense used in the patent law (35 USC 101), each the printed matter and said “relationship” is not functional because it is neither “tied to a particular apparatus” nor “operates to change materials to ‘a different state or thing’” (*IN RE COMISKEY*, CAFC 2006-1286, September 2007).

² Applicant is put on notice that this “wherein” clause is not a step nor does it add structure, so the examiner was NOT required to give this clause patentable weight; see para. xx in this Office action.

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7. In addition, applicant is put on notice that claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure (MPEP § 2111.04). The subject claim language, and indeed most of the “wherein” clauses, do not limit claim scope and do not deserve patentable weight.
8. Note on interpretation of claim terms - Unless a term is given a “clear definition” in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so “with reasonable clarity, deliberateness, and precision” (MPEP § 2111.01.III). A “clear definition” must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as “by xxx we mean”; “xxx is defined as”; or “xxx includes, ... but does not include ...”. An example does not constitute a “clear definition” beyond the scope of the example.
9. The instant application contains no such clear definition for the phrase “statistical analysis”. The phrase is supported by example usage (e.g., at para. [0045] of the published application (US 20030126011A1), but does not meet the requirements for a “clear definition.” In the instant case, the examiner is required to give the term “statistical analysis” its broadest reasonable interpretation, which the examiner judges to be any mathematical consideration of information. That includes the use of set logic, which is taught inherently by Schulze, Jr. (col. 18 lines 34-39).
10. Schulze, Jr. also teaches at the citations given above claims 2, 5, 9, 12, 20 and 25.
11. Schulze, Jr. also teaches claims 3, 4, 23 and 24 (col. 18 lines 19-24 and 34-39); claim 6-8, 14-16, 21 and 26 (col. 2 lines 4-52); and claim 19 (*database 228*, col. 9 line 26-29).
12. Claims 10, 11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulze, Jr. (US005483049A). Schulze, Jr. does not teach inserts (claims 10 and 17) with the mailed coupons/checks and an incentive chosen so as to maximize profit (claim 11).

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Official notice is taken (MPEP § 2144.03) that both of these limitations were in common use, and therefore obvious to one of ordinary skill in the art, at the time of the instant invention.

13. Traverse of the taking of Official Notice - Applicant has traversed the examiner's taking of official notice (pp. 15-18 of the arguments filed on 9 April 2007). However, applicant has not provided adequate information or argument so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the official notice (MPEP § 2144.03). An effective traverse must be based on alleged evidence, not mere denial. Applicant could, for example, have gotten testimony from an economics professor saying that it is not notoriously common to try to maximize profit. Or applicant could have offered testimony from a mailing firm testifying that it is not notoriously common for checks to be sent with informational inserts. The examiner would then have been compelled to produce counter evidence in order to maintain the taking of official notice. But applicant submitted no such evidence. Therefore, the presentation of a reference to substantiate the official notice is not deemed necessary. The examiner's taking of official notice is maintained.

Response to Arguments

14. Applicant's arguments filed on 3 April 2008 have been fully considered but they are not persuasive. With the exceptions given below, these arguments fail to comply with 37 CFR 1.111(b) because applicant's arguments amount to a general allegation that the claims define a patentable invention without distinctly and specifically pointing out the supposed errors in the examiner's action.
15. Indeed, it appears that applicant has not read the last Office action. For example, applicant argues (p. 16) that the rejection fails to provide support for the claim 18 rejection statement that "generating a list of prospective merchants' is inherent". Such support was provided in para. 14 of the Office action mailed on 1 November 2007.
16. Also, applicant argues (p. 20) that the examiner has not given the applicant a reasonable opportunity to rebut the taking of official notice. The examiner told applicant precisely how the taking could be overcome (para. 8 of the Office action mailed on 1 November 2007). Applicant does not specifically and distinctly point out the supposed errors in that reply.

Conclusion

17. This is a continuation of applicant's earlier Application No. 10032469. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
18. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.
20. The examiner's supervisor, James W. Myhre, can be reached on 571-272-6722.
21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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22. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
23. Applicant may have after final arguments considered and amendments entered by filing an RCE.
24. **ABANDONMENT** – If examiner cannot by telephone verify applicant’s intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office’s web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

8 June 2008

/Donald L. Champagne/
Primary Examiner, Art Unit 3688